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EXAMINER

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1617

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 29

Application Number: 09/360,521
Filing Date: July 23, 1999
Appellant(s): RESTLE ET AL.

Mark Feldstein
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/27/03, Paper No. 28.

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(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The rejection of claims 1-46 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

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(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

6,159,914	DeCoster et al.	510/119
6,162,424	Decoster et al.	424/70.17
5,476,649	Naito et al.	424/70.1
5567428	Hughes	424/401
6,162,423	Sebag et al.	424/70.12
WO 98/03155	Sebag et al.	1/98

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Appellant's arguments filed 1/28/03 and 3/27/03, are *persuasive to overcome the Double Patenting Rejections* in the Previous Office Action. Thus, this rejection is hereby withdrawn.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sebag et al. (WO 98/03155) in view of Hughes (5,567,428) in further view of Naito (5,476,64).

Sebag et al. teach washing and conditioning compositions containing silicone and dialkyl ether. Disclosed are compositions comprising at least one silicone, at least one surfactant, and at

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least one dialkylether in a cosmetically acceptable aqueous medium. Polyorganosiloxanes containing substituted or unsubstituted amine groups are disclosed. A mixture of anionic surfactant with amphoteric surfactant is disclosed as being added to the composition. The surfactants are disclosed as comprising 5-50% of the composition. Ethanol, isopropanol, butanol, propylene glycol and glycol ethers are disclosed as solvents in the aqueous medium. Synthetic oils and cationic polymers of formula (a) of the instant invention are disclosed as additives. Example 1 teaches a shampoo comprising imidazoline-based amphoteric surfactant and sodium lauryl ether sulphate (anionic surfactant) in a ratio of 2/7. The reference fails to teach preferred aminated silicones and 18-methyl-eicosanoic acid. U.S. 6,162,432 is relied upon as a translation for WO 98/03155. See Col. 2, line 26-Col. 24, line 10.

Hughes teaches topical personal care compositions containing polysiloxane-grafted adhesive polymers. Disclosed is a hair styling/conditioning rise composition comprising trimethylsilylamodimethicone (an aminated silicone of formula II of the instant invention), ditallow dimethyl ammonium chloride (cationic polymer), tallow trimethyl ammonium chloride (cationic polymer), and amodimethicone, which meets claims 13-21, 26-31. Cationic polymers disclosed include diallyldimethylammonium salt homopolymers, copolymers of diallyldimethylammonium salt and acrylamide, cationic polysaccharides, and copolymers of vinylpyrrolidone and methylvinylimidazolium salt, which meets claims 34, 36-38. Carriers disclosed include C1-C12 alcohols, such as ethanol, which meets claims 40 and 42. Disclosed as polymer plasticizing agents are glycerin (glycerol) and propylene glycol comprising 0.01-10% of the composition, which meets claims 40-43. See Col. 2, lines 42-Col. 3, line 55; Col. 11, line 15-Col. 36, line 12; Col. 37, line 61-Col. 40, line 11.

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Naito et al. teach hair cosmetic compositions comprising branched fatty acids. 18-methyleicosanoic acid is disclosed as the preferred branched fatty acid. See Col. 1, line 53-Col. 5, line 58; Col. 8, line 34-Col. 26, line 33.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the alkylamino substituted silicones of Hughes, such as the aminated silicones of formula I and IV of the instant invention, for the aminated silicones of Sebag et al. because a) both references teach cosmetic compositions for use on hair; b) both references teach aminated silicones as active agents; c) Hughes teaches his aminated silicones as increasing style hold strength of hair and as decreasing drying time; hence, the replacement of one for the other for cosmetic purposes would be within the skill of one in the art because of the expectation of achieving a hair care product that increases the style hold strength of the hair and decreases the hair's drying time.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the 18-methyl-eicosanoic acid of Naito et al. to the composition of the combined references because a) the combined references and Naito et al. both teach hair cosmetic compositions; b) Sebag et al. teach synthetic oils as additives and 18-methyl-eicosanoic acid is a synthetic oil; c) Naito et al. teach 18-methyl-eicosanoic acid as giving hairs excellent moist, soft, smooth and glossy conditioning effects which continue to persist after repeated shampooings; hence, the addition of 18-methyl-eicosanoic acid to the compositions of the combined references for the cosmetic treatment of hair would be within the skill of one in the art.

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Claims 1-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Decoster et al. (6,162,424) in view of Hughes in further view of Naito et al.

Decoster et al. teach cosmetic compositions comprising, in a cosmetically acceptable medium, at least one silicone and at least one polymer containing units of the diallyldimethylammonium type. Amodimethicone and trimethylsilylamodimethicone are disclosed as silicones. Surfactants are disclosed as part of the composition, wherein a mixture of at least one anionic surfactant and at least one amphoteric surfactant is preferred. Surfactants can comprise 0.1-60% of the composition. Synthetic oils are disclosed as additives. Example 1 teaches a composition comprising sodium lauryl ether sulphate (anionic surfactant), aminosilicone, and diallyldimethylammonium chloride homopolymer (amphoteric surfactant). The reference fails to teach preferred aminated silicones, 18-methyl-eicosanoic acid, and preferred solvents. See Col. 1, line 30-Col. 16, end.

Hughes is disclosed as discussed above.

Naito et al. is disclosed as discussed above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the alkylamino substituted silicones of Hughes, such as the aminated silicones of formula I and IV of the instant invention, for the aminated silicones of Decoster et al. because a) both references teach cosmetic compositions for use on hair; b) both references teach aminated silicones as active agents; c) Hughes teaches his aminated silicones as increasing style hold strength of hair and as decreasing drying time; hence, the replacement of one for the other for cosmetic purposes would be within the skill of one in the art because of the expectation of

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achieving a hair care product that increases style hold strength of hair and decreases hair's drying time.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the 18-methyl-eicosanoic acid of Naito et al. to the composition of the combined references because a) the combined references and Naito et al. both teach hair cosmetic compositions; b) Decoster et al. teach synthetic oils as additives and 18-methyl-eicosanoic acid is a synthetic oil; c) Naito et al. teach 18-methyl-eicosanoic acid as giving hairs excellent moist, soft, smooth and glossy conditioning effects which continue to persist after repeated shampoos; hence, the addition of 18-methyl-eicosanoic acid to the compositions of the combined references for the cosmetic treatment of hair would be within the skill of one in the art.

(11) Response to Argument

Appellant argues, "The Examiner argues, as alleged motivation, that 'substituting one for the other for hair conditioning purposes, would be within the skill of one in the art' . . . However, the Federal Circuit has repeatedly and clearly held that similar conclusory statements are insufficient to establish a prima facie case of obviousness". This argument is not persuasive, as the Appellant has misconstrued the Examiner's motivational statement by including only the conclusory sentence, wherein the motivational statement spanned a paragraph. The following is the full motivational statement, as stated in the above rejection, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to substitute the alkylamino substituted silicones of Hughes, such as the trimethylsilylamodimethicone of formula II of the instant invention, for the aminated silicones of Sebag et al. because a) both references teach

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cosmetic compositions for use on hair; b) both references teach aminated silicones as active agents; c) Hughes teaches his aminated silicones as increasing style hold strength of hair and as decreasing drying time; hence, the replacement of one for the other for cosmetic purposes would be within the skill of one in the art because of the expectation of achieving a hair care product that increases the style hold strength of the hair and decreases the hair's drying time.

Appellant argues, "since Hughes's amodimethicones and Sebag's silicones are disclosed for separate and independent functions, there would have been no motivation to make the proposed substitution". This argument is not persuasive. The Examiner respectfully points out that both Hughes and Sebag are directed toward cosmetic hair care compositions that wash and condition the hair.

Appellant argues, "Sebag teaches using silicones as conditioners. . .In contrast, amodimethicones selected by the Examiner from Hughes have a distinct function. They are drying aids". This argument is not persuasive, as there is motivation to combine the two references. It is respectfully pointed out that Sebag et al. teaches that additional conditioning agents, such as oils, emollients, and cationic polymers, can be added to their composition. Thus, one of skill in the art would have been motivated to substitute the aminated silicones of formula I or IV of the instant invention taught Hughes, for the aminated silicones of Sebag et al. because of the expectation of providing a product that additionally increases the style hold strength of hair and decreases the hair's drying time, in addition to conditioning the hair.

Appellant argues, "The drying aids are not taught to have any utility in the absence of the volatile, water-insoluble solvent for the adhesive polymer". This argument is not persuasive.

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The Examiner respectfully points out that Sebag et al. teach that volatile solvents such as lower alcohols and cyclic silicones, are ingredients in their composition.

Appellant argues, “there would have been no utility, desirability, or motivation, based on the cited references, to add or substitute a drying aid according to Hughes into the water based compositions according to Sebag, which do not contain a volatile, water-insoluble solvent that needs to be evaporate. Moreover, while the compositions according to Hughes are applied and then evaporated the example compositions according to Sebag are all shampoos that are applied and washed away”. This argument is not persuasive, as Appellant is arguing against the preferred embodiments of the inventions. It is respectfully pointed out that it is well-established that consideration of a reference is not limited to the preferred embodiments or working examples, but extends to the entire disclosure for what it fairly teaches, when viewed in light of the admitted knowledge in the art, to person of ordinary skill in the art. In re Boe, 355 F.2d 961, 148 USPQ 507, 510 (CCPA 1966); In re Lamberti, 545 F.2d 747, 750, 192 USPQ 279, 280 (CCPA 1976); In re Fracalossi, 681 F.2d 792, 794, 215 USPQ 569, 570 (CCPA 1982); In re Kaslow, 707 F.2d 1366, 1374, 217 USPQ 1089, 1095 (Fed. Cir. 1983). The Examiner respectfully points out that Sebag et al. broadly teach their invention as foaming compositions for washing **and conditioning** keratinous materials, particularly hair **and skin**. Furthermore, the Examiner respectfully points out that Hughes et al. do teach shampoos as forms of their compositions, and that Hughes et al. specifically exemplify a shampoo as a preferred form of their composition.

Applicant argues, “During the November 12, 2002, Examiner’s interview, the Examiner appeared to take the position that as long as two components are both cosmetic composition

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components, there is no need to show any motivation for the proposed substitution and that the proposed substitution is in no way improper given the different functions of the components". This argument is not persuasive, as the discussion in the interview initiated by Applicant, has been misconstrued. It is respectfully pointed out that the Examiner has not and does not take the position that as long as two components are both cosmetic composition components, there is no need to show any motivation for the proposed substitution. The Examiner's position is that there always needs to be motivation to combine two references even when they are typical ingredients in a common art. For the reasons argued above and the above rejection, the Examiner does not think the instant substitution is improper.

Regarding the ratio of the surfactants, Appellant argues, "since there is no basis or evidence that has been pointed to justify selecting a particular ratio from one particular example and freely combining this ratio with other aspects of the reference". This argument is not persuasive. In Col. 9, lines 11-15, of Sebag et al., it is taught that "A particularly preferred mixture is a mixture consisting of at least one anionic surfactant with at least one amphoteric or zwitterionic surfactant". In Col. 9, lines 41-46, of Sebag et al., it is taught that "The surfactants are generally used in the compositions in accordance with the invention in sufficient proportions to give the composition a detergent nature, these proportions preferably being between 5 and 50%. . . and in particular between 8 and 35%". In Col. 17, lines 36-60, of Sebag et al., a composition is exemplified wherein the ratio of amphoteric to anionic surfactant is 2:7, which is greater than 0.2:1, as recited in the instant claims.

In response to appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on

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obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues, "the rejection is flawed for failing to appreciate that not all chemical compounds will have the given property at a specific value or range. For example mass is an inherent property, but not all polymers have a mass of, for instance, greater than 20,000 units. Likewise, not all aminosiloxanes, including not all amodimethicone, have an amine number of greater than or equal to 0.4 meq/g". This argument is not persuasive. The Examiner respectfully points out that while not all polymers have a mass of 20,000 units, two of the same specie of polymers will have the same mass. Likewise, while not all amodimethicones will have an amine number of greater than or equal to 0.4 meq/g, two of the same specie of amodimethicones will have an identical amine number. In the instant case, it is respectfully pointed out that the compound and its defined variables of Hughes et al. in Col. 13, line 60-Col. 14, line 19, is the exact same compound of formula (I) of the instant invention with the same defined variables. Additionally, it is respectfully pointed out that the compound and its defined variable of Hughes et al. in Col. 14, lines 35-55, is the exact same compound of formula (IV) of the instant invention with the same defined variables. It is therefore respectfully pointed out that the amine numbers must be identical, as a compound and its properties are inseparable (*In re Papesch*, 315 F.2d 381, 137 USPQ 43 (CCPA 1963), and Applicant has defined the compounds of formula (I) and (IV) as having an amine number greater than or equal to 0.4meq/g.

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Appellant argues, "It may not have been appreciated that even though Hughes discloses as a drying aid the general amodimethicone structure. . .there is no guidance of any kind in Hughes directing one to make such a selection". This argument is not persuasive. The compounds of Hughes et al. described in the previous paragraph that are identical to formulas (I) and (IV) of the instant invention are taught as preferred and are exemplified in numerous examples in the Examples of Hughes et al.

Appellant argues, that unexpected results have been achieved. This argument is not persuasive. First, it is respectfully pointed out that Appellant has not compared the instant composition with that of the closest prior art. Second, it is respectfully pointed out that Appellant's data is not commensurate in scope with the instant claims, as the instant claims recite an incredible number of ratios of amphoteric to anionic surfactant, so long as the ratio is greater than 0.2:1, and the instant claims recite an incredible number of amodimethicones of formulas (I) and (IV) that have an amine number of greater than or equal to 0.4meq/g.

Appellant argues, "As disclosed in Decoster '424. . .Example 1, composition A does, however, contain 2.56 grams of disodium cocoamphodiacetate, which is an amphoteric surfactant, and also contains 15.5g of the anionic surfactant sodium lauryl ether sulphate. Accordingly, the ratio. . .is 0.165:1. In any event, in contrast to these weight ratios, the presently claimed compositions must have an amphoteric/anionic surfactant ratio of greater than or equal to 0.2:1, as set forth more specifically in the claims". This argument is not persuasive. First, the Examiner respectfully points out that a reference is considered as a whole and not limited to its preferred embodiments. Second, the Examiner respectfully points out that Example 3 of Decoster, in Col. 12, lines 15-30, teach a ratio of amphoteric surfactant to anionic surfactant that

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meets the limitations of the instant claims. Example 3 teaches sodium lauryl ether sulfate (anionic surfactant) as comprising 15.5g and cocobetaine containing 35% AM (amphoteric surfactant) as comprising 3.2g, which results in an amphoteric to anionic surfactant ratio of 0.2:1. Third, the Examiner respectfully points out, in reference to the surfactant ratio of Example 1 of Decoster, above, that rounding the ratio of 0.165:1 to the tenth decimal point, as recited in the instant claims, results in a ratio of 0.2:1.

Appellant argues, "a particular parameter must first be recognized as a result-effect variable before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation". This argument is not persuasive. It is respectfully pointed out that Decoster recognizes the ratio of surfactants to be a result-effective variable. In Col. 7, lines 34-41, the references teaches, "The compositions of the invention also advantageously contain at least one surfactant which is generally present in an amount range from approximately 0.1% to approximately 60% by weight. . .preferably from 5% to 30%. . .The surfactant can be selected from anionic, amphoteric, nonionic or cationic surfactants, or mixtures thereof". In Col. 9, lines 24-30, Decoster teaches, "In the compositions in accordance with the invention, mixtures of surfactants are preferably used. . .A particularly preferred mixture is a mixture comprising at least one anionic surfactant and at least one amphoteric surfactant. As described in the above paragraph, Decoster, exemplifies different amphoteric to anionic surfactant ratios. Furthermore, it is respectfully pointed out that it is well known in the cosmetic art to vary the ratio of surfactants in a given composition in order to increase or decrease stability, to increase or decrease the detergency of a composition, and to increase or decrease the irritation a composition imparts to the skin.

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In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Appellant argues, "Given the different uses for the silicones of the two respective references, there would have been no motivation for the proposed substitution and hence, no prima facie case of obviousness". This argument is not persuasive. See the motivational statement in the above rejection and the Examiner's response to this argument in reference to Sebag and Hughes, in the above paragraphs.

Appellant argues, "The reference combination fails to teach or suggest an aminated silicone having an amine number greater than or equal to 0.4 meq/g". Appellant argues that he has achieved unexpected results. These arguments are not persuasive. These arguments are addressed in the above paragraphs in reference to Sebag and Hughes.

For the above reasons, it is believed that the rejections should be sustained.

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Respectfully submitted,

LQ Wells

Lauren Q. Wells

June 20, 2003

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